The opinion in support of the decision being entered today
was not written for publication
and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH ORESTE CARNALI and YAN ZHOU

Appeal 2006-3000
Application 09/758,685[1]
Technology Center 1700

Oral Argument: None
Decided: September 26, 2006

Before: McKELVEY, *Senior Administrative Patent Judge*, and SCHAFER and TORCZON, *Administrative Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

A. Introduction

The appeal is from a decision of the Primary Examiner rejecting claims 1-12 on appeal as being anticipated under 35 U.S.C. § 102(b) over European Patent Application 0 851 022 A2, published 01 July 1998.

We affirm.

---

[1] Application filed 11 January 2001. The real party in interest is Unilever Home & Personal Care USA, Division of Conopco, Inc.

B. Record considered

The record considered in the appeal consists solely of:

1. The specification, drawings and claims as originally filed.
2. European Patent Application 0 851 022 A2.
3. The final rejection entered 11 December 2003
4. Brief for Appellants filed 15 March 2004.
5. Order returning undocketed appeal to Examiner entered 18 July 2005.
5. Supplemental Examiner's Answer mailed on 27 or 28 July 2005.
6. Examiner's communication mailed 9 August 2005.
7. Appeal docketing notice of appeal received on 15 August 2006.

C. The invention

The invention sought to be patented can be understood by reference to claims 1 and 12.

Claim 1

A mechanical dishwashing composition comprising:

(A) an anti-scaling polymer formed from

(i) 50 to 99% by weight of the polymer of an olefinically unsaturated carboxylic acid monomer;

(ii) 1 to 50% of at least one monomer unit selected from the group consisting of copolymerizable sulfonated monomers, copolymerizable nonionic monomers and mixtures thereof;

(B) 0.1 to 99.9% of a vehicle designed to release at least an effective amount of the polymer to prevent scaling;

wherein said polymer is released into a cold, penultimate rinse cycle preceding a heated, final rinse cycle of a dishwashing sequence;

wherein said vehicle of (B) is defined as (1) the sum of all components forming said composition except for said antiscaling polymer; or (2) an encapsulating material or other slow release protective chemical or device.

The claim is peculiar in that it is directed to a "composition" and yet it requires that a specific method step be performed, *viz.*, "wherein said polymer is released into a cold, penultimate rinse cycle preceding a heated, final rinse cycle of a dishwashing sequence." The method step in no way defines the "composition." We have treated the method step as defining a "property" of the composition, or as the Examiner indicated (Examiner's Answer, page 6), as a statement of intended use, *i.e.*, that the composition must be capable of being used in the manner otherwise set out in the method step. In the event of further prosecution, attention is directed to *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005) (single claim covering both an apparatus and a method of use of that apparatus held to be indefinite under the second paragraph of 35 U.S.C. § 112); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Int. 1990) (same). Claims 1-11 are indefinite, but we have proceeded with the appeal giving those claims the construction we believe applicants intended. *Cf. Stelos Co., Inc. v. Hosiery Motormend Corp.*, 295 U.S. 237, 243 (1935).

Claim 12

A method for washing soiled dishes comprising charging a mechanical dishwashing composition to a wash liquour in a washing machine, the composition comprising [a composition defined essentially the same as the composition of claim 1]

wherein said method comprises charging said dishwashing composition to a cold, penultimate rinse cycle preceded by a heated, final rinse cycle of a dishwashing sequence.

D. Discussion

We are told in the specification under a heading styled "The Related Art," which we take to mean the prior art, that "[t]he machine dishwashing process comprises washing articles in a main wash cycle and rinsing them in one or more rinse cycles." Specification, page 1, ¶ 0002, lines 1-2. Generally the wash program of a machine dishwasher involves a sequence of water fill, wash/rinse and water drain cycles which are automatically performed by the machine without operator intervention. Specification, page 5, ¶ 00013, lines 1-3. Applicants' description of the prior art is consistent with our experience with dishwashers. What applicants apparently believe is novel is the use of the anti-scaling polymer and vehicle in what applicants call a penultimate rinse and preferably both the penultimate rinse and a final rinse cycle. Specification, page 5, ¶ 00013, lines 3-8. The invention "contrasts with [what is said to be the] historic practice in this art of dosing scale inhibitors via rinse cycle compositions added only to the final rinse cycle." Specification, page 5, ¶ 00013, lines 8-10. Applicants go on to say that "[i]t is not generally appreciated that any component of the role of a rinse cycle composition can be efficiently

performed from other than the final rinse cycle." Specification, page 5, ¶ 00013, lines 10-12.

Composition claims 1-11 stand or fall together. Claim 12 is argued separately. Brief for Appellants, page 11 (filed 15 March 2004).

The Primary Examiner rejected claims 1-12 as being anticipated under 35 U.S.C. § 102(b) over European Patent Application 0 852 022 A2, published 01 July 1998.

The European Patent Application (EPA) names applicants as inventors. Applicants in the Brief for Appellants do not argue that the European Patent Application fails to describe applicants' composition. In particular, applicants do not tell us why or how the Primary Examiner is supposed to have erred in rejecting composition claims 1-11. 37 CFR § 41.67(c)(1)(vii) (a brief must contains the contentions with respect to each issue). Accordingly, there is no basis for reversing the decision to reject those claims.

With respect to method claim 12, it is argued that the Primary Examiner erroneously found that EPA describes a process of using the composition in all phases of a rinse cycle. Brief for Appellants, page 12. We are told that the Primary Examiner's "reading of the art is simply strained ..." *Id.* Also, the Primary Examiner is said to have overlooked clear advantages of using the composition in the penultimate rinse stage as opposed to a final rinse stage. *Id.* EPA is said to talk "only of a final rinse step (singular not plural)." *Id.* Without explaining why, applicants maintain that they "have provided a showing that the stage of introduction does make a difference" and that the Primary Examiner's rejection is based on "hindsight." *Id.* We proceed to an analysis of EPA based on the arguments which are presented on a single page of the Brief for Appellant (page 12).

According to EPA, "[t]he machine dishwashing process comprises washing articles in a main wash cycle and *rinsing them in one or more rinse cycles*." (Emphasis added). Page 1, lines 10-11. EPA goes on to say "[a] rinse aid composition is designed for use in the final rinse step of the machine dishwashing operation, separately from the detergent composition used in the main wash cycle." Page 1, lines 11-12. Based on the last sentence, in this appeal applicants seemingly attempt to limit the description of the use of the compositions of EPA to only a final rinse. Use of the composition in the final rinse is more likely a preferred embodiment of EPA. Inconsistent with applicants' current argument is their "pre-litigation" EPA statement that "[t]he invention is also directed to a method of using the polymers in machine dishwashing ..." (page 2, lines 14-15) and claim 10. EPA claim 10 describes "[a] method of rinsing tableware in a machine dishwasher with a rinse aid composition useful for inhibiting scale comprising the steps of ... introducing the rinse aid into *a* rinse cycle of a machine dishwasher to inhibit scale formation." (Emphasis added). Applicants now attempt to place a narrow construction on what they describe in EPA. The credible description of the prior art "one or more rinse cycles" (EPA, page 1, lines 10-11) and EPA claim 10 provide a more than adequate basis for finding that a person having ordinary skill in this art, considering EPA as a whole, would understand that EPA describes the use of the composition in any rinse cycle. We find it unlikely that a mechanical dishwasher would ordinarily include more than a small number of rinse cycles. A disclosure that a composition can be used in a rinse cycle is a description to a person having ordinary skill of using the composition in the known penultimate and final rinse cycles. *Cf. In re Petering*, 301 F.2d 676,

133 USPQ 275 (CCPA 1962) and *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978).

Contrary to applicants' argument, the Primary Examiner's reading of EPA is not strained. Instead substantial evidence supports the Primary Examiner's finding that EPA describes the use of the composition in a known prior art rinse cycle, including a penultimate rinse cycle. Also, the Primary Examiner also did not improperly fail to accord proper weight to an alleged showing that use of the composition in the penultimate step "does make a difference." Whether the alleged showing is relevant or irrelevant with respect to a rejection under 35 U.S.C. § 103, it is not material with respect to anticipation. *Cf. In re Schaumann*, *supra*.

E. Order

Upon consideration of the record set out in Part B, and for the reasons given, it is

ORDERED that the decision of the Primary Examiner rejecting claims 1-12 is affirmed.

FURTHER ORDERED that the provisions of 37 CFR § 1.136(a) are not applicable to time periods for taking subsequent action.

/ss/ Fred E. McKelvey	)	
FRED E. McKELVEY	)	
Senior Administrative Patent Judge	)	
	)	BOARD OF
/ss/ Richard E. Schafer	)	PATENT
RICHARD E. SCHAFER	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
/ss/ Richard Torczon	)	
RICHARD TORCZON	)	
Administrative Patent Judge	)	

cc (via First Class Mail):

Ronald A. Koatz, Esq.
UNILEVER INTELLECTUAL PROPERTY GROUP
700 Sylvan Avenue
Bldg C2 South
Englewood Cliffs, NJ 07632-3100

Tel: 201-840-2912
Fax: 201-894-2400
Email: None